

REMARKS

Claims 1 and 3-11 are the claims currently pending in the Application.

The Examiner objects to the first full paragraph of page 18 of the Specification.

The paragraph is amended to correctly cite the U.S. Application number for the reference identified. Therefore, this objection should now be withdrawn.

Rejection of Claims 1, 3-8, 10 and 11 under 35 U.S.C. § 103

Claims 1, 3-8, 10 and 11 are rejected under 35 U.S.C. § 103¹ as being obvious from what the Examiner alleges is Applicants' Admitted Prior Art (AAPA). This rejection is traversed. Further, to the extent that the rejection was intended as a rejection under 35 U.S.C. § 102, since as discussed below, the cited references do not disclose features of Applicant's invention as claimed in independent claim 1, the rejection is also traversed as a rejection under 35 U.S.C. § 102.

¹ The 35 U.S.C. § 103 rejection detailed on pages 2-3 of the Office Action states near the bottom of page 2 that the claims are rejected under 35 U.S.C. § 102(b). However, when the rejection is read in its entirety, including the Examiner's attempted combination of different references cited by Applicant's specification (Office Action, page 3), and the recitation on page 3 that "[t]herefore, it would have been clearly obvious ... to modify" the alleged AAPA cited, it seems that a rejection under 35 U.S.C. § 103 was intended. Accordingly, Applicant responds to the rejection as a rejection under 35 U.S.C. § 103.

Among the insights behind Applicant's claimed invention is that a PIP (picture in picture) may be positioned or sized based on a characteristic, such as a continuous color or a continuous texture of the primary image to minimize disruption or obstruction of the primary image.² According to an aspect of Applicant's claimed invention, the PIP display is changed upon determining that a characteristic in the primary image is present, such as determining a continuous color portion. For example, according to an aspect of Applicant's claimed invention, the PIP may be repositioned over the continuous portion detected. The AIPA does not disclose or suggest this insight recognized by Applicant's disclosure, let alone disclose or suggest the solutions provided by Applicants' claimed invention.

Features of Claim 1 Not Disclosed

Independent claim 1 requires that the processor change a PIP display characteristic in response to the determination that at least one characteristic is present in the primary image, the characteristic being at least one of a continuous color portion and a continuous texture portion.

Pages 1-3 of the Specification cites a reference (alleged by the Office Action to be admitted prior art) that discloses a picture in picture (PIP) that is repositioned in response to detected motion between frames of a video image and

² This discussion illustrates aspects of Applicant's claimed invention. Applicant does not represent that every embodiment of Applicant's claimed invention necessarily embodies or provides the solutions herein discussed.

discloses changing the size of the displayed PIP. The Office Action also cites pages 10, 11 and 13-17 of Applicant's disclosure, where references are cited that disclose analyzing a picture signal to determine the presence of continuous color, text, or person images in the received picture signal.

The cited references, when taken together, do not disclose or suggest a relationship between the detection of the presence of a characteristic, such as a continuous color pattern in the primary image, and changing the PIP display characteristic, such as the position of the PIP. That is, the AAPA does not disclose or suggest changing a PIP characteristic, such as the position of the PIP, in response to a characteristic in the primary image, such as a continuous color portion detected in the primary image.

Clearly, the AAPA does not disclose or suggest that a PIP display characteristic is changed in response to the determination that the at least one characteristic is present in the primary image, the characteristic being at least one of a continuous color portion and a continuous texture portion, as *inter alia* required by independent claim 1.

Accordingly, the rejection of claim 1 whether under 35 U.S.C. § 103 or under 35 U.S.C. § 102 is improper because the recitations of independent claim 1 are not disclosed or suggested by the cited references, even when combined.

Non-Obviousness

Further, the cited references do not disclose or suggest the insights recognized by Applicant's claimed invention, and therefore, the solutions provided by Applicant's invention would not have been obvious from the cited references. For example, the cited references do not disclose or suggest that a PIP may be positioned or sized based on a continuous color or a continuous texture of the primary image. Therefore, the cited references belong to the prior art identified by Applicant's claimed invention and do not even remotely disclose or suggest Applicant's invention as claimed in claim 1.

Moreover, Applicant respectfully submits that there would have been no suggestion or motivation for combining and modifying the references as proposed. The Office Action states that modifying the "AAPA which discloses the changing of a PIP display based on motion, by also changing the PIP display based upon the importance/non-importance of a scene(s) to ensure the viewer is able to view the desirable portions of an image" (Office Action, page 3) would have been obvious.

It is respectfully submitted that the general teaching advanced in the Office Action "changing the PIP display based upon the importance/non-importance of a scene(s)" would not have led a person or ordinary skill to the solutions claimed in independent claim 1 of Applicant's invention. It is respectfully submitted Applicant's invention as claimed in claim 1 would not have been obvious from "the importance/non-importance of a scene(s)" teaching, even if disclosed in the prior art. For example, the relationship between the detection of a continuous color pattern in the primary image, and

changing the position of the PIP, would not have been obvious based on the general motivation advanced. Therefore, Applicant's invention as claimed in claim 1 would not have been obvious to a person of ordinary skill in the art without resort to impermissible hindsight reconstruction based on Applicant's own disclosure.

Dependent Claims

Claims 3-8, 10 and 11 depend from independent claim 1, and thus incorporate novel and non-obvious features thereof. Therefore, claims 3-8, 10 and 11 are patentably distinguishable over the prior art for at least the reasons that independent claim 1 is patentably distinguishable over the prior art. Accordingly, this rejection should now be withdrawn.

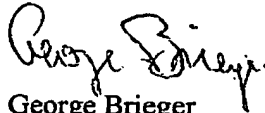
Rejection of Claim 9 under 35 U.S.C. § 103

Claim 9 is rejected under 35 U.S.C. § 103 as being obvious from Applicants' admitted prior art (AAPA) in view of Rainville et al., U.S. Patent No. 2002/0069411. This rejection is traversed.

Claim 9 depends from independent claim 1, and thus incorporates novel and nonobvious features thereof. Rainville does not remedy the deficiencies of independent claim 1. Accordingly, claim 9 is patentably distinguishable over the prior art for at least the reasons that independent claim 1 is patentably distinguishable over the prior art. Therefore, this rejection should now be withdrawn.

For at least the reasons set forth in the foregoing discussion, Applicant believes that the Application is now allowable, and respectfully requests that the Examiner reconsider the rejections and allow the Application. Should the Examiner have any questions regarding this Amendment, or regarding the Application generally, the Examiner is invited to telephone the undersigned attorney.

Respectfully submitted,



George Brieger
Registration No. 52,652

Scully, Scott, Murphy & Presser
400 Garden City Plaza
Suite 300
Garden City, New York 11530
(516) 742-4343, Ext. 503